

REMARKS

Reconsideration of this application is respectfully requested.

The examiner has stated that the application names joint inventors, and thus presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. The examiner's assumption is correct, and therefore this issue is believe to be resolved.

Claims 1, 6 and 8 were finally rejected under 35 U.S.C. 103(a) as being unpatentable over Betz (U.S. 3,087,251) in view of Buck (U.S. 2,022,756). Claims 1, 5 and 7 were rejected under 35 U.S.C. 103(a) as being unpatentable over Betz (U.S. 3,087,251) in view of Mosman (U.S. 4,977,684) and Buck (U.S. 2,022,756). Claims 2 and 9, however, were deemed allowable if rewritten to include all of the limitations of the base claim and any intervening claims. Also, the examiner stated that:

*In response to applicant's argument that the prior art does not disclose nor suggest the use of a projecting object free tounge as claimed by applicant: Betz teaches a tongue 15 having an outer end being generally free of projecting objects mounted thereon. The limitation "generally free of projecting objects mounted thereon" means that there can be at least one projecting object. Therefore, even though the tongue 15 has a clip 13 projecting therefrom, it is "generally" free of projecting objects.*

Applicants have amended claims 1 and 8 to more distinctly claim those features of their invention which are unique and novel over the prior art. Specifically, applicants have amended claims 1 and 8 to include the previous restrictions of claims 2 and 9 respectively, thus effectively rewriting those claims in independent form. Also, applicants have added new claim 12 which states that the forward tongue is free of projecting objects. As was stated in the previous response of October 29, 2004, the cited patent, Mosman, teaches the use of an extendable tail on a tape measure for measuring inside measurements. As argued by the examiner, it would have been obvious to modify Mosman to include inside and outside measurements as taught by Buck and further to include a tongue as taught in Betz and Valentine. However, modification of Mosman in this manner will not replicate applicants' invention. Why not? Because the use of a tongue as taught by Betz includes a downwardly projecting clip section which would prevent the extension of the tongue into narrow spaces as is desired with applicants invention. Furthermore, as shown in Mosman Figures 6-9, the downwardly projecting clip section is an integral part of the Mosman device and removal of it would

1 be contrary to the teachings of Mosman. In fact, the only suggestion to modify Mosman as suggested  
2 by the examiner is found in applicants' disclosure, and nowhere else in the cited prior art. It can  
3 fairly be said that the cited prior art does not disclose nor suggest the use of a projecting object free  
4 tongue as currently claimed by applicants, and modification of Mosman to include such a tongue will  
5 cause Mosman to not function as intended by its inventor. As was stated by the C.C.P.A. in In re  
6 Rosen; "The modification necessary to the primary reference in order to achieve the patented design  
7 may not destroy fundamental characteristics of the primary reference." In re Rosen, 673 F.2d 388,  
8 391, 213 USPQ 347, 350 (C.C.P.A. 1982). Applicants have made these changes as per the  
9 examiner's suggestions and thus believe that claims **1, 8 and 12** are allowable over the prior art.

10        Claims **5, 6 and 7** were rejected along with claim **1**, but applicants wish to clarify that they  
11 do not claim exclusive rights to the features defined in those claims independently, but rather only  
12 in combination with the present invention as defined in claim **1**. For the reasons expressed above  
13 in connection with amended claim **1** and for the structural limitations added by these claims, claims  
14 **5, 6 and 7** are believed to be allowable with claim **1**. Claims **2, 3, 4, 9, 10 and 11** have been  
15 canceled.

1 This application is thus believed to be in condition for allowance of all claims remaining  
2 herein, and such action is respectfully requested.

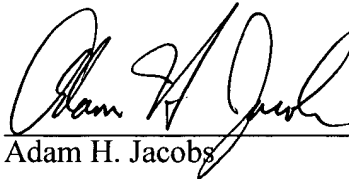
3 Respectfully submitted,

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11 CERTIFICATE OF MAILING

12 I hereby certify that this Amendment for a DUAL OPTION TAPE MEASURE, Serial N<sup>o</sup>  
13 10/700,943, was mailed by first class mail, postage prepaid, to Mail Stop Non-Fee Amendment,  
14 Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 15th day of March,  
15 2005.

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17 Adam H. Jacobs